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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,667	10/17/2000	Steven MacWilliams	224.013US1	3418

7590

03/24/2003

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EXAMINER

CARTER, MONICA SMITH

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 03/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No. 09/690,667		Applicant(s) MACWILLIAMS, STEVEN	
Examiner Monica S. Carter		Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 8, 30-32 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Cunningham ('144).

Cunningham discloses a label for attaching over an edge of a stock (as seen in figures 1, 5, 6, and 8), the label comprises a first layer (21, 22) having a first surface adapted to be printed on (as seen in figure 2) and a second surface (undersurface of 21, 22); a second layer (11) including a non-adhesive label material which is permanently attached to the second surface of the first layer (see col. 2, lines 26-31); the second layer having an adhesive on an outer surface of the non-adhesive label material (see col. 2, lines 23-26); the non-adhesive label material of the second layer having a first section (13) and a second section (14) having a gap therebetween (see col. 2, lines 5-20, Cunningham discloses a spacing between sections 13 and 14 along the center line of the second layer 11), the gap defining a fold-line section in the first layer (see col. 2, lines 12-17), the second layer covers substantially all of the second surface of the first layer (as seen in figure 2); the label folds along a fold line section such that a first section of the second layer is attachable to a first side of the stock

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member and a second section of the second layer is attachable to a second side of the stock member (as seen in figures 5 and 8).

Regarding claim 8, Cunningham discloses that neither the first section nor the second section of the second layer bend when the folding pressure is applied to the label (as seen in figures 1 and 5).

Regarding claims 30-32, the method of applying the label to an edge of a stock member is disclosed in the above rejections.

Regarding claim 34, see the above rejections to claim 1.

3. Claims 6, 7, 9-29 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham, as used above.

Cunningham discloses the claimed invention except for the fold-line section being off-set from a centerline of the first layer (claim 6). It would have been obvious to one having ordinary skill in the art at the time the invention was made to position the fold-line section along any desired location of the first layer, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Regarding claims 7 and 21, Cunningham discloses only one gap in the second layer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any number of gaps in the second layer as desired by the end user, since it has been held that mere duplication of essential working parts of a

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device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claims 9-14, 21, 23, 29 and 33, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired material having different characteristics such as color depending on the end result desired, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 15-17, Cunningham, discloses that the gap indicates a label fold-line in the first layer for matching with the edge of the stock member and the first layer folds along the fold-line section when a force is applied (as seen in figures 5 and 8).

Regarding claims 18-20 and 22-25, see the above rejections.

Regarding claim 26, Cunningham discloses the claimed invention as set forth above, except for the label having a backing member. It is commonly known to provide removable backing liners (such as silicone-based liners) to adhesive labels. It would have been obvious to one having ordinary skill in the art to provide a backing member to the label of Cunningham to provide a protective covering for the adhesive layer and then remove the covering when the label is to be applied to a stock material.

Regarding claim 27, Cunningham discloses one or more label members attached to the at least two sections of the second layer (as seen in figures 6 and 8).

Regarding claim 28, Cunningham discloses each of the label members having a perimeter edge which matches an edge of the at sections of the second layer (as seen in figure 6).

Response to Arguments

4. Applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

March 21, 2003

Monica S. Carter
MONICA CARTER
PATENT EXAMINER